REMARKS

Claims 1-34 stand examined and are rejected on various grounds. These rejections are addressed in the appropriate sections below. Claims 4, 16-17, 24, and 30-31 are presently amended.

In view of the preceding amendments and the remarks made herein, the present application is believed to be in condition for allowance.

Rejections Under 35 U.S.C. § 103(a) of Claims 1-8

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,418,421 (Hurtado) in view of U.S. Patent No. 6,714,921 (Stefik). Although the Examiner cited both Hurtado and Stefik in the rejection of claim 1, the Examiner does not indicate how Stefik would be combined with Hurtado to disclose the limitations claimed in claim 1. According to MPEP Section 2142, the Examiner bears the initial burden to provide a "convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP § 2142 further states: "A statement of a rejection that includes a large number of rejections must explain with reasonable specificity at least one rejection, otherwise the examiner procedurally fails to establish a prima facie case of obviousness. Ex parte Blanc, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989)." Given the Examiner's rejection, Applicants are unable to discern how Stefik would be combined with Hurtado to make claim 1 unpatentable. Applicants submit that because the Examiner has failed to establish a *prima facie* case of obviousness, the rejection of claim 1 should be withdrawn.

In a good-faith effort to advance prosecution of the claims presented, Applicant will attempt to respond to the Examiner's rejections. With respect to claim 1, the Examiner cites to col. 6, lines 3-36 of Hurtado for alleged disclosure of each limitation of claim 1. Applicant respectfully submits that Hurtado does not disclose all the limitations of claim 1. For instance, claim 1 recites, "determining, based on the information about the particular media playback device, whether the

particular media playback device has the capability to enforce the expiration rules associated with the one or more media files." (Emphasis added.)

By contrast, the cited portion of Hurtado describes, in part: "[o]ne embodiment of the present invention provides a method of playing digital content data that has been compressed and encrypted with a first encrypting key on a system" (col. 6, lines 5-8), and "[a]nother embodiment of the present invention provides a digital content player for playing digital content that has been compressed and encrypted with a first encrypting key." (col. 6, lines 24-27).

With respect to claim 2, the Examiner also points to col. 9, line 53 - col. 10, line 28 in Hurtado. The cited portion of Hurtado discloses, in part:

> enforcement of content usage according to the conditions of purchase or license, such as permitted number of copies, number of plays, and the time interval or term the license may be valid. (Col. 9, Lines 58-62)
>
> The Clearinghouse(s) provides licensing authorization by enabling intermediate or End-User(s) to unlock content after verification of a successful completion of a licensing transaction. Secure Containers are used to distribute encrypted content and information among the system components. A SC is a cryptographic carrier of information or content that uses encryption, digital signatures, and digital certificates to provide protection against unauthorized interception or modification of electronic information and content. (Col 10, Lines 1-10)

Applicant is unable to locate where Hurtado describes "determining, based on the information about the particular media playback device, whether the particular media playback device has the capability to enforce the expiration rules associated with the one or more media files" and "if the media playback device has the capability to enforce the expiration rules, formatting the requested one or more media files such that they can only be rendered by the particular playback device and transferring the formatted files and the expiration rules to the particular media playback device" (emphasis added), as recited in claim 1.

Applicant notes that Stefik discloses, in part:

> Digital works are stored in repositories. Repositories enforce the usage rights for digital works. Each repository has a "generic ticket agent" which punches tickets. In some instances only the generic ticket agent is necessary. In other instances, punching by a "special ticket agent" residing on another repository may be desired. Punching by a "special ticket agent" enables greater security and control of the digital work. For example, it can help prevent digital ticket forgery. Special ticket agents are also useful in situations where an external database needs to be updated or checked. (Col. 4, Lines 10-20).
>
> A digital ticket may be used in many commercial scenarios such as in the purchase of software and prepaid upgrades. A digital ticket may also be used to limit the number of times that a right may be exercised. For example, a user may purchase a copy of a digital work, along with the right to make up to 5 Copies. In this case, the Copy right would have associated therewith a digital ticket that can be punched up to 5 times. Other such commercial scenarios will become apparent from the detailed description. (Col. 4, Lines 24-32).

Applicant cannot discern how the teachings of Stefik can be combined with Hurtado to disclose "determining, based on the information about the particular media playback device, whether the particular media playback device has the capability to enforce the expiration rules associated with the one or more media files" and "if the media playback device has the capability to enforce the expiration rules, formatting the requested one or more media files such that they can only be rendered by the particular playback device and transferring the formatted files and the expiration rules to the particular media playback device", as recited in claim 1.

With respect to claim 3, the Examiner cites Hurtado col. 10, lines 29-45 as disclosing the additional limitations of claim 3, which depends from claim 1. This section of Hurtado discloses, in part:

> The control of Content usage is enabled through the End-User Player Application 195 running on an End-User Device(s). The application embeds a digital code in every copy of the Content that defines the allowable number of secondary copies and play backs. Digital watermarking technology is used to generate the digital code, to keep it hidden from other End-User Player Application 195, and to make it resistant to alteration attempts. In an alternate embodiment, the digital code is just kept as part of the usage conditions associated with the Content 113. When the Digital Content 113 is accessed in a compliant End-User Device(s), the End-User Player Application 195 reads the watermark to check the use restrictions and

> updates the watermark as required. If the requested use of the content does not comply with the usage conditions, e.g., the number of copies has been exhausted, the End-User Device(s) will not perform the request.

Applicant submits that this section of Hurtado does not disclose, "obtaining information about a user account associated with the particular media playback device, the user account having associated usage rights; determining, based on the information about the user account, whether the usage rights satisfy the content rights associated with the one or more media files; and if the usage rights do not satisfy the content rights, denying transfer of the one or more media files to the particular playback device", as recited in claim 3.

For at least the reasons given above, the Examiner has failed to established a *prima facie* case of obviousness of claim 1. In addition, the Applicant has made a full and good faith effort to advance prosecution of the claims presented in light of the rejections. Therefore, the Applicant respectfully requests withdrawal of the rejection of claim 1 and claims 2-8, which depend from claim 1, and allowance of claims 1-8.

Rejections Under 35 U.S.C. § 103(a) of Claims 9-15

Claims 9-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,418,421 (Hurtado) in view of U.S. Patent No. 6,714,921 (Stefik). As with claim 1, the Examiner does not indicate how Stefik would be combined with Hurtado to disclose the limitations claimed in claim 9. The Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness.

The Examiner cites Hurtado Col 6, Lines 3-36 (the same passage that was cited in the rejection of claim 1) as disclosing all the limitations of claim 9. Claim 9 recites in part, "comparing the current expiration rules with expiration rules stored on the content server for the one or more media files to determine if the current expiration rules can be updated; if the current expiration rules can be updated, transferring new expiration rules from a content server to the particular media playback device; if the current expiration rules cannot be updated, requesting a user of the

particular media playback device to perform an action before the current expiration rules can be updated; and if the user performs the requested action, transferring new expiration rules from the content server to the particular media playback device." Referring to the excerpted Hurtado sections *supra,* Applicant fails to detect how Hurtado discloses these limitations of claim 9. Applicant also does not see how Stefik cures the deficiencies of Hurtado.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness of claim 9 and its dependent claims 10-15. Applicant respectfully requests withdrawal of the Examiner's rejection and allowance of claims 9-15.

Rejections Under 35 U.S.C. § 103(a) of Claim 16-20:

Claims 16-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,418,421 (Hurtado) in view of U.S. Patent No. 6,714,921 (Stefik). As with claims 1 and 9, the Examiner does not indicate how Stefik would be combined with Hurtado to disclose the limitations claimed in claim 16. The Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness of claim 16.

Claim 16 has been amended to additionally recite, in part: "validating a storage medium on the particular playback device". Support for this amendment is found at least on page 8 at lines 11-16 and lines 21-30, page 12 at lines 1-10 and element 307 of figure 3. Applicant cannot discern how the limitations of claim 16 are disclosed by Hurtado in combination with Stefik.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness of claim 16 and its dependent claims 17-20. Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 16-20.

Rejections Under 35 U.S.C. § 103(a) of Claims 21-29:

Claims 21-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,418,421 (Hurtado) in view of U.S. Patent No. 6,714,921 (Stefik). As with claims 1, 9, and 16, the Examiner does not indicate how Stefik would be combined with Hurtado to disclose the limitations claimed in claim 21. The Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness of claim 21.

In addition, Applicant cannot discern how Hurtado, either alone or in combination with Stefik, discloses a "means for determining, based on the information about the particular media playback device, whether the particular media playback device has the capability to enforce the expiration rules associated with the one or more media files" (emphasis added), as recited in claim 21.

Because the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Applicant respectfully requests withdrawal of this rejection and allowance of claim 21. Because claims 22-29 depend from claim 21, Applicant requests withdrawal of the rejection and allowance of these claims as well.

Rejections Under 35 U.S.C. § 103(a) of Claim 30-34:

Claims 30-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,418,421 (Hurtado) in view of U.S. Patent No. 6,714,921 (Stefik). As with claims 1, 9, 16, and 21, the Examiner does not indicate how Stefik would be combined with Hurtado to disclose the limitations claimed in claim 30. The Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness of claim 30.

In addition, claim 30 now recites a "means for validating a storage medium on the particular playback device". Applicants cannot discern how Hurtado, either alone or in combination with Stefik, discloses the claimed limitations of claim 30.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness of claim 30 and its dependent claims 31-34. Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 30-34.

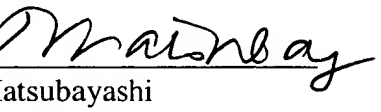
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. ***566472000400***. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: October 13, 2004

Respectfully submitted,

By 

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